

## REMARKS

Claims 1-14, 16-30 and 42-55 are pending in the application. Claims 1, 42 and 55 have been amended. Claims 15 and 31-41 have been canceled without prejudice.

### *Claim Rejections – 35 U.S.C. § 103*

The Patent Office rejected claims 1-4, 6-10, 15-19, 21, 26-34, 35, 41, 50 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle").

The Patent Office rejected claims 5, 11-13, 36-40 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto").

The Patent Office rejected claims 14, 20 and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Jachimowicz et al., U.S. Patent No. 5,734,154, ("Jachimowicz").

The Patent Office rejected claims 42-47 under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto").

The Patent Office rejected claims 48 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman").

The Patent Office rejected claims 49 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Bashan et al., U. S. Patent No. 6,202,927, ("Bashan") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher").

The Patent Office rejected claim 53 under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto") in view of O'Gorman et al., U.S. Patent No. 6,970,584, ("O'Gorman") in further view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher").

The Patent Office rejected claim 54 under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto") in further view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher").

Applicant respectfully traverses each rejection under 35 U.S.C. § 103(a). The present application is directed to a transaction authentication card including a biometric sensor which may be utilized to gain access to a restricted area when a biometric feature matches stored biometric data. In an advantageous aspect of the present invention, the transaction authentication card of the present invention may enroll a user without any additional equipment. Thus, biometric information, which is very precious to many users, is not deposited within a database and may never be retrieved.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Additionally, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732

F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Applicant respectfully submits claims 1, 42 and 55 recite elements which have not been disclosed, taught or suggested by Bashan, Doyle, Elteto, Jachimowicz, O'Gorman and Moster, individually or in combination. For example, claim 1 recites the transaction authentication card is a stand alone device and performs self authentication, self verification, and self enrollment, amended from former claim 15. Claims 42 and 55 recite a transaction authentication card which includes a processor, the processor being configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said user acquired during enrollment within said first memory. Bashan, Doyle, Elteto, Jachimowicz, O'Gorman and Moster, individually or in combination, fail to disclose, teach or suggest the transaction authentication card is a stand alone device and performs self authentication, self verification, and self enrollment as recited in claim 1 or a transaction authentication card which includes a processor, the processor being configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said user acquired during enrollment within said first memory as recited in claims 42 and 55.

In the rejection of claim 15, the Patent Office cites Doyle, paragraph [0064], lines 5-6. This passage states, "Because the signature message can only be decrypted with the signing party's public key, a second party can use the first party's public key to confirm that the signature message did in fact originate with this first party." This passage does not disclose self enrollment or self registration as asserted by the Patent Office. In fact, no where in this passage or throughout the disclosure of Doyle discloses self enrollment of self registration. Additionally, Doyle, nor any other cited reference, discloses a transaction authentication card which includes a processor, the processor being configured for enrollment of said biometric feature of said user and storage of said biometric data representing said biometric feature of said user acquired during enrollment

within said first memory. Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claims 1, 42 and 55. Claims 2-14, 16-30 and 43-54 should be allowed due to their dependence upon an allowable base claim.


### **CONCLUSION**

In light of the forgoing, entry of the amendment and allowance of the claims is earnestly solicited.

Respectfully submitted,

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